

Doc Code: AP.PRE.REQ

PTO/SB/33 (11-08)
Approved for use through 12/31/2008. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

YONE3019/JJC/PMB

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number

10/565,503

Filed

January 23, 2006

First Named Inventor

Keitaro YONEZAWA

Art Unit

3723

Examiner

Robert C. WATSON

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Patrick M. Buechner, Reg. #57,504/

Signature

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/06)

PATRICK M. BUECHNER

Typed or printed name

☐ attorney or agent of record.
Registration number _____

703-683-0500

Telephone number

☒ attorney or agent acting under 37 CFR 1.34.

December 10, 2008

Date

Registration number if acting under 37 CFR 1.34 57,504

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Application No.	10/565,503	Examiner:	Robert C. WATSON
First Inventor:	Keitaro YONEZAWA	Art Group Unit:	3723
Filed:	January 23, 2006	Confirmation No.:	9795
Atty. Docket No.	YONE3019/JJC/PMB	Customer No.:	23364
For:	CLAMPING APPARATUS		

Mail Stop AF
COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

**REMARKS ACCOMPANYING
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

SIR:

Applicants respectfully request that a Pre-Appeal Brief Conference be initiated in accordance with the extension of the pilot program outlined in the Official Gazette notice of February 7, 2006.

These remarks and the request for the Pre-Appeal Brief Conference are concurrently filed with a Notice of Appeal in the above-identified application.

For the reasons discussed below, the current rejection of claims 1, 4-6, 8, and 9 suffers from both clear factual and legal deficiencies, and thus Applicants respectfully request that the application be allowed on the existing claims.

REJECTION OF CLAIMS 1, 4-6, 8, AND 9 UNDER 35 U.S.C. § 103(a)

Claims 1, 4-6, 8, and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent no. 6,095,509 (*Yonezawa*, the '509 patent) in view of U.S. patent no. 4,059,036 (*Hartley*) in view of U.S. patent no. 4,767,125 (*Barry et al.*) and further in view of U.S. patent no. 6,604,738 (*Haruna*).

A. Factual Deficiency in Rejection

It is respectfully submitted that there is a clear factual deficiency in the rejection of claim 1, from which the remaining claims depend.

In particular, it is respectfully submitted that the proposed combination of the '509 patent and the *Hartley*, *Barry*, and *Haruna* patents fails to disclose at least an inner engaging member that is axially movably arranged on an outer periphery of a pull rod, a plurality of outer engaging members arranged on an outer periphery of an inner engaging member, and an output portion of a pull rod connected to the outer engaging members, all as required by pending claim 1.

As detailed on pages 5 and 6 of the response filed August 6, 2008, the '509 patent fails to disclose a plurality of outer engaging members arranged on an outer periphery of an inner engaging member and adapted to wedge-engage with the inner engaging member and also fails to disclose a plurality of outer engaging members arranged on an outer periphery of the inner engaging member, and an output portion of a pull rod connected to the outer engaging members, all as required by pending claim 1.

As further detailed on page 9 of the response filed August 6, 2008, the *Hartley* patent fails to disclose the missing features of the '509 patent. In particular, the *Hartley* patent fails to disclose a plurality of outer engaging members that are connected to an output portion of a pull rod, as is required by pending claim 1.

As further discussed on page 9 of the response filed August 6, 2008, the *Barry* and *Haruna* patents do not disclose structure sufficient to overcome the above noted deficiencies in the proposed combination of the '509 patent and the *Hartley* patent.

Therefore, there is a clear factual error in the rejection of claim 1 on the basis that the proposed combination of the '509 patent and the *Hartley*, *Barry*, and *Haruna* patents fails to disclose at least an inner engaging member that is axially movably arranged on an outer periphery of a pull rod, a plurality of outer engaging members arranged on an outer periphery of an inner engaging member, and an output portion of a pull rod connected to the outer engaging members, all as required by pending claim 1.

Since there is a clear factual error in the rejection of claim 1, from which the remaining claims depend, a *prima facie* case of obviousness with respect to claim 1 cannot be established, and withdrawal of this rejection, and allowance of the application on the existing claims is respectfully requested.

B. Legal Deficiency in Rejection

It is respectfully submitted that there is a clear legal deficiency in the rejection of claim 1, from which the remaining claims depend.

In particular, it is respectfully submitted that a person having ordinary skill in the art would not have combined the features of the '509 patent and the *Hartley*, *Barry*, and *Haruna* patents.

In particular, since the proposed combination of the '509 patent and the *Hartley* patent would be insufficient to create a proper clamp mechanism, for the reasons discussed in detail on pages 7-9 of the response filed August 6, 2008, a person having ordinary skill in the art would not have altered the structure of the '509 patent with the structure of the *Hartley* patent in the manner proposed.

Therefore, there is a clear legal error in the rejection of claim 1 on the basis that a person having ordinary skill in the art would not have combined the features of the '509 patent and the *Hartley*, *Barry*, and *Haruna* patents in the manner as required by pending claim 1.

Since there is a clear legal error in the rejection of claim 1, from which the remaining claims depend, a *prima facie* case of obviousness with respect to claim 1 cannot be established, and withdrawal of this rejection, and allowance of the application on the existing claims is respectfully requested.

CONCLUSION

Based upon the clear factual and legal deficiencies in the above-noted rejection, Applicants respectfully request that the application be allowed on the existing claims.

BACON & THOMAS, PLLC
625 Slaters Lane, Fourth Floor
Alexandria, Virginia 22314-1176
Phone: (703) 683-0500
Facsimile: (703) 683-1080

Date: December 10, 2008

Respectfully submitted,

/Patrick M. Buechner, Reg. #57,504/

PATRICK M. BUECHNER
Attorney for Applicants
Registration No. 57,504